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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: GATELY, MAURICE K. et al.

Serial No.: To Be Assigned  
(Division Of Serial No.  
08/459,151)

Group Art Unit: To Be  
Assigned

Examiner: To Be Assigned

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Attorney Docket No.: 1803-247

For: PURIFICATION AND  
CHARACTERIZATION OF  
CYTOTOXIC LYMPHOCYTE  
MATURATION FACTOR AND  
MONOCLONAL ANTIBODIES  
THERE TO

REQUEST UNDER 37 C.F.R. §§ 1.607 and 1.608(a)  
FOR INTERFERENCE WITH A PATENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. §§ 1.607 and 1.608(a),  
Applicants hereby seek to have an interference declared  
between the above-identified application, Serial No.  
unassigned, (the "instant application") and Trinchieri et al.  
United States Patent No. 5,811,523 (the "'523 patent";  
attached hereto as Exhibit A), entitled "Antibodies To Natural  
Killer Stimulatory Factor," which issued September 22, 1998  
from application Serial No. 956,240 (the "'240 application"),  
filed October 22, 1997. The '523 patent claims priority under  
35 U.S.C. § 120 as a divisional of application Serial No.  
858,000, filed May 16, 1997, which is a continuation of



application Serial No. 403,013, filed March 13, 1995, which issued July 15, 1997 as United States Patent No. 5,648,467 (the "'467 patent"), which is a division of application Serial No. 584,941, filed September 18, 1990, which issued October 10, 1995 as United States Patent No. 5,457,038 (the "'038 patent"; attached hereto as Exhibit B), which is a continuation-in-part of application Serial No. 307,817 (the "'817 application"; attached hereto as Exhibit C), filed February 7, 1989, now abandoned, which is a continuation-in-part of application Serial No. 269,945 (the "'945 application"; attached hereto as Exhibit D), filed November 10, 1988, now abandoned.

The instant application claims priority under 35 U.S.C. § 120 as a continuation application of application Serial No. 459,151 (the "'151 application"), filed June 2, 1995, pending, which is a divisional of application Serial No. 205,011 (the "'011 application"), filed March 2, 1994, now abandoned, which is a divisional of application Serial No. 857,023 (the "'023 application"), filed March 24, 1992, now abandoned, which is a continuation-in-part of application Serial No. 572,284 (the "'284 application"; a copy of which is attached hereto as Exhibit E), filed August 27, 1990, now abandoned, which is a continuation-in-part of application Serial No. 520,935 (the "'935 application"), filed May 9, 1990, now abandoned, which is a continuation-in-part of application Serial No. 455,708 (the "'708 application"), filed

December 22, 1989, now abandoned. The instant application and the applications to which it claims priority are assigned to Hoffmann-LaRoche Inc.

This Request is accompanied, inter alia, by a Declaration of Thomas E. Friebel Under 37 C.F.R. § 1.608(a), and a Declaration of Dr. David H. Presky.

In this request, Applicants propose a single count directed to an antibody which specifically reacts with natural killer cell stimulatory factor ("NKSF"), which, as discussed below, is also known as cytotoxic lymphocyte maturation factor ("CLMF") and IL-12. Claims 1-7 of the '523 patent should be designated as corresponding to the proposed count. Claims 33-38 of the instant application should be designated as corresponding to the proposed count.

## **I. BACKGROUND**

The '523 patent describes a cytokine it refers to as natural killer cell stimulatory factor (NKSF), while the instant application describes a cytokine it refers to as cytotoxic lymphocyte maturation factor (CLMF). Subsequent analyses of NKSF and CLMF have revealed that the two cytokines are, in fact, identical. The cytokine is also known as IL-12, and has now become the preferred designation for this cytokine.

IL-12 is a heterodimeric polypeptide of approximately 70 kD (kilodaltons) that is made up of two

subunits: a first subunit having a size of approximately 40 kD and a second subunit having a size of approximately 30-35 kD when the subunits are analyzed under reducing conditions via SDS polyacrylamide gel electrophoresis (PAGE).

The heterodimeric form of IL-12 exerts multiple biological effects on certain immune cells such as T lymphocytes natural killer (NK) cells. For example, IL-12 induces production of such cytokines as interferon gamma and tumor necrosis factor (TNF), induces proliferation of activated T and NK cells, enhances the cytotoxic activity of both resting T and NK cells, and, in conjunction with IL-2, induces generation of lymphokine-activated killer (LAK) cells. Neither IL-12 subunit, alone, exhibits such biological activities.

Conditions that stimulate production of IL-12 heterodimer (e.g., phytohemagglutinin induction of peripheral blood lymphocytes) also induce production of free IL-12 40 kD subunit. Stimulation can result in a large excess of free 40 kD subunit.

## II. PROPOSED COUNT

In this Request, Applicants propose a single count, as follows:

### Proposed Count

An antibody which specifically reacts with a protein capable of inducing the production of gamma interferon in vitro in human peripheral blood

lymphocytes (PBLs), or of inducing phytohemagglutinin-activated PBLs, and comprises:

- (a) a first subunit having an apparent molecular weight of approximately 40 kD under reducing conditions on SDS PAGE and comprising the following amino acid sequence:

Ile Trp Glu Leu Lys Lys Asp Val Tyr Val  
Val Glu Leu Asp Trp Tyr Pro Asp Ala Pro  
Gly Glu Met Val Val Leu Thr Cys Asp Thr  
Pro Glu Glu Asp Gly Ile Thr Trp Thr Leu  
Asp Gln Ser Ser Glu Val Leu Gly Ser Gly  
Lys Thr Leu Thr Ile Gln Val Lys Glu Phe  
Gly Asp Ala Gly Gln Tyr Thr Cys His Lys  
Gly Gly Glu Val Leu Ser His Ser Leu Leu  
Leu Leu His Lys Lys Glu Asp Gly Ile Trp  
Ser Thr Asp Ile Leu Lys Asp Gln Lys Glu  
Pro Lys Asn Lys Thr Phe Leu Arg Cys Glu  
Ala Lys Asn Tyr Ser Gly Arg Phe Thr Cys  
Trp Trp Leu Thr Thr Ile Ser Thr Asp Leu  
Thr Phe Ser Val Lys Ser Ser Arg Gly Ser  
Ser Asp Pro Gln Gly Val Thr Cys Gly Ala  
Ala Thr Leu Ser Ala Glu Arg Val Arg Gly  
Asp Asn Lys Glu Tyr Glu Tyr Ser Val Glu  
Cys Gln Glu Asp Ser Ala Cys Pro Ala Ala  
Glu Glu Ser Leu Pro Ile Glu Val Met Val  
Asp Ala Val His Lys Leu Lys Tyr Glu Asn  
Tyr Thr Ser Ser Phe Phe Ile Arg Asp Ile  
Ile Lys Pro Asp Pro Pro Lys Asn Leu Gln  
Leu Lys Pro Leu Lys Asn Ser Arg Gln Val  
Glu Val Ser Trp Glu Tyr Pro Asp Thr Trp  
Ser Thr Pro His Ser Tyr Phe Ser Leu Thr  
Phe Cys Val Gln Val Gln Gly Lys Ser Lys  
Arg Glu Lys Lys Asp Arg Val Phe Thr Asp  
Lys Thr Ser Ala Thr Val Ile Cys Arg Lys  
Asn Ala Ser Ile Ser Val Arg Ala Gln Asp  
Arg Tyr Tyr Ser Ser Ser Trp Ser Glu Trp  
Ala Ser Val Pro Cys Ser;

and

- (b) a second subunit having an apparent molecular weight of approximately 30-35 kD under reducing conditions on SDS PAGE and comprising the following amino acid sequence:

Arg Asn Leu Pro Val Ala Thr Pro Asp Pro  
Gly Met Phe Pro Cys Leu His His Ser Gln  
Asn Leu Leu Arg Ala Val Ser Asn Met Leu

Gln Lys Ala Arg Gln Thr Leu Glu Phe Tyr  
 Pro Cys Thr Ser Glu Glu Ile Asp His Glu  
 Asp Ile Thr Lys Asp Lys Thr Ser Thr Val  
 Glu Ala Cys Leu Pro Leu Glu Leu Thr Lys  
 Asn Glu Ser Cys Leu Asn Ser Arg Glu Thr  
 Ser Phe Ile Thr Asn X Ser Cys Leu Ala  
 Ser Arg Lys Thr Ser Phe Met Met Ala Leu  
 Cys Leu Ser Ser Ile Tyr Glu Asp Leu Lys  
 Met Tyr Gln Val Glu Phe Lys Thr Met Asn  
 Ala Lys Leu Leu Met Asp Pro Lys Arg Gln  
 Ile Phe Leu Asp Gln Asn Met Leu Ala Val  
 Ile Asp Glu Leu Met Gln Ala Leu Asn Phe  
 Asn Ser Glu Thr Val Pro Gln Lys Ser Ser  
 Leu Glu Glu Pro Asp Phe Tyr Lys Thr Lys  
 Ile Lys Leu Cys Ile Leu Leu His Ala Phe  
 Arg Ile Arg Ala Val Z Ile Asp Arg Val  
 Met Ser Tyr Leu Asn Ala Ser,

wherein X is Gly or Glu, and Z is Thr or Tyr.

Claims 1-7 of the '523 patent and Claims 33-38 of the instant application should be designated as corresponding to the proposed count.

**A. Claims 1-7 Of The '523 Patent  
 Correspond To The Proposed Count**

Applicants propose that each of the claims, i.e., Claims 1 through 7, of the '523 patent be designated as corresponding to the proposed count. The claims do not correspond exactly to the proposed count, but are directed to the same patentable invention as the proposed count. 37 C.F.R. §1.601(n).

Although the protein recited in Claim 1 is not identical to the protein recited in the proposed count, an antibody which specifically reacts with the protein recited in Claim 1 is not patentably distinct from an antibody which

specifically reacts with the protein recited in the proposed count. In fact, the recited proteins are identical. First, the size and amino acid sequence of the 40 kD protein subunit recited in (a) of the proposed count corresponds exactly to that of the first subunit recited in Claim 1. It is noted that the amino acid sequence in (a) of the proposed count is identical to the sequence depicted in '523 patent FIG. 1 from amino acids 23 to 328, as recited in (a) of Claim 1 of the '523 patent.

Further, the activity of the protein recited in the proposed count is identical to that of the NKSF protein recited in the '523 patent. The ability to induce production of gamma interferon in vitro in PBLs is explicitly recited in Claim 1. In addition, the '523 patent teaches that NKSF induces proliferation of phytohemagglutinin (PHA)-activated PBLs (c. 21, ll. 34-54).

With respect to the amino acid sequence of the 30-35 kD subunit, the mature form of the 30-35 kD subunit recited as amino acids 57-253 in Fig. 2 and the issued claims of the '523 patent differs at two amino acid residues from the mature form of the 30-35 kD subunit amino sequence depicted by amino acids 23-219 in Fig. 26 of the instant application. In particular, these two sequences differ at positions 142 and 242 of Fig. 2 of the '523 patent, which depict glutamic acid (Glu) and tyrosine (Tyr), respectively, and corresponding positions 108

and 208 of Fig. 26 of the instant application, which depict glycine (Gly) and threonine (Thr), respectively.

It is estimated that the two differences are due to an error in listing the derived amino acid sequence shown in '523 patent Fig. 2, in that the nucleotide codons depicted in the figure that code for these two amino acid residues code for glycine and threonine, respectively, which would make the 30-35 kD subunit of the '523 patent sequence identical to that of the instant application. Thus, it appears that the 30-35 kD subunit actually obtained in the '523 patent is identical to the 30-35 kD subunit described in the instant application.

Nonetheless, the proposed count is broad enough to encompass an antibody which specifically binds to the recited protein antigen wherein the protein comprises a 30-35 kD subunit having either the mature sequence in instant application Fig. 26 or the mature sequence depicted in '523 patent Fig. 2. At the time an interference is initially declared, a count shall not be narrower in scope than any claim designated to correspond to the count. 37 C.F.R. §1.606.

In particular, the two possible amino acid residue differences are reflected in the positions designated "X" and "Z" in the amino acid sequence of the subunit recited in (b) of the proposed count. The amino acid residue at position X corresponds to position 142/108 described above, and can be either Gly or Glu. The amino acid residue at position Y



corresponds to position 242/208 described above, and can be either Thr or Tyr.

At most, the protein antigen recited in Claim 1 can only differ from the protein antigen recited in the proposed count by two amino acid residues within one of the protein's subunits. Antibodies which specifically react with a protein exhibiting these two possible amino acid differences cannot be considered patentably distinct and correspond to the same patentable invention as that of the proposed count. As such, Claim 1 should be designated as corresponding to the proposed count.

Claim 2, which depends from Claim 1, and independent Claim 6, recite an antibody which specifically reacts with the first (40 kD) NKSF subunit. As the 40 kD subunit recited in claim 1 is identical to the 40 kD subunit recited in the proposed count, the antibodies recited in Claims 2 and 6 specifically react with the 40 kD protein subunit recited in the proposed count. The antibodies recited in Claims 2 and 6, therefore, are directed to the same patentable invention as the proposed count and should be designated as corresponding to the proposed count.

Claim 3, which depends from Claim 1, and independent Claim 7, recite an antibody which specifically reacts with the second (30-35 kD) NKSF subunit. The 30-35 kD subunit recited in Claims 3 and 7 differ, at most, by two amino acid residues from the antibodies recited in the proposed count. Therefore,

antibodies which specifically react with the protein subunit recited in Claims 3 and 7 are not patentably distinct from antibodies which specifically react with the 30-35 kD subunit of the proposed count. As such, the antibodies recited in Claims 3 and 7 are directed to the same patentable invention as the proposed count and should be designated as corresponding to the proposed count.

Claims 4 and 5 depend from Claim 1 and specify that the antibody is a murine or a human antibody, respectively. It is well known that antibodies are produced by mammals, including mice and humans. Thus, Claims 4 and 5 define the same patentable invention as the proposed count. Accordingly, Claims 4 and 5 should be designated as corresponding to the proposed count.

**B. Claims 33-38 Of The Instant Application  
Correspond To The Proposed Count**

**1. Applicants' Claims 33-38**

Applicants' Claims 33-38, the only pending claims in the instant application, do not correspond exactly to the proposed count, but all of these claims should be designated as corresponding to the proposed count because they are all directed to the same invention. 37 C.F.R. § 1.601(n).

For convenience, Claims 33-38 of the instant application are repeated below:

33. A monoclonal antibody which

specifically reacts with  
cytotoxic lymphocyte maturation  
factor (CLMF) protein, wherein  
said protein is substantially  
free of other proteinaceous  
materials and comprises:

- (a) a first subunit having an  
apparent molecular weight of  
approximately 40 kD under  
reducing conditions on SDS PAGE  
and comprising the amino acid  
sequence of FIG. 25A-25D from  
amino acids 23 to 328; and
- (b) a second subunit having an  
apparent molecular weight  
of approximately 30-35 kD  
under reducing conditions  
on SDS PAGE and comprising  
the amino acid sequence of  
FIG. 26A-26C from amino  
acid 23 to 219.

- 34. The monoclonal antibody of  
Claim 33 wherein the CLMF  
protein is capable of inducing  
proliferation of  
phytohemagglutinin (PHA) -  
activated peripheral blood  
lymphocytes.
- 35. The monoclonal antibody of  
Claim 33 wherein said antibody  
reacts with said first subunit.
- 36. The monoclonal antibody of  
Claim 33 wherein said antibody  
reacts with said second subunit.
- 37. A monoclonal antibody which  
specifically reacts with a  
subunit of cytotoxic lymphocyte  
maturation factor (CLMF)  
protein, said subunit having an  
apparent molecular weight of  
approximately 40 kD under  
reducing conditions on SDS PAGE  
and comprising the amino acid  
sequence of FIG. 25A-25D from  
amino acids 23 to 328.

38. A monoclonal antibody which specifically reacts with a subunit of cytotoxic lymphocyte maturation factor (CLMF) protein, said subunit having an apparent molecular weight of approximately 0-35 kD under reducing conditions on SDS PAGE and comprising the amino acid sequence of FIG. 26A-26C from amino acid 23 to 219.

**2. Support In Applicants' Specification  
For Claims 33-38**

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Claims 33-38 are fully supported in the specification of the instant application as discussed below.

Claims 33 and 34 are directed to a monoclonal antibody which specifically reacts with CLMF protein, said CLMF protein comprising a subunit of 40 kD under reducing conditions comprising the amino acid sequence of instant application Figure 25A-25D from amino acid residues 23 to 328, and a subunit of 30-35 kD under reducing conditions comprising the amino acid sequence of instant application Figure 26A-26C from amino acid residues 23 to 219. Claim 34, which depends from Claim 33, recites one of the biological activities of the CLMF protein, in particular that the CLMF protein can induce proliferation of phytohemagglutinin (PHA)-activated peripheral blood cells.

These claims are fully supported by the instant application. Working Example 13 (pp. 71-78) describes the successful generation and characterization of monoclonal antibodies directed against CLMF. The structural features and biological activity of the CLMF protein recited in the claims

are as characterized and described in the instant application. For a characterization of the size and amino acid sequence of the two CLMF subunits, see, e.g., p. 33, ll. 10-12 and Figure 7; p. 64, ll. 10-17 and Fig. 25A-25D; and p. 67, ll. 5-15 and Fig. 26A-26C. The ability of the CLMF protein to induce proliferation of PHA-activated peripheral blood cells (referred to in the specification as a "T cell growth factor (TGF) assay") is described and demonstrated at p. 19, l. 15 to p. 21, l. 2, and in working Example 9 (pp. 54-60).

Claim 35, which depends from Claim 33, and independent Claim 37 are directed to monoclonal antibodies that react with the 40 kD CLMF subunit. Working example 13 describes the production and characterization of monoclonal antibodies which specifically react with the 40 kD CLMF subunit. See especially p. 73, l. 20 to p. 74, l. 9.

Claim 36, which depends from Claim 33, and independent Claim 38 are directed to monoclonal antibodies that react with the 35 kD CLMF subunit. Example 14 (pp. 79-80) describes a method for producing monoclonal antibodies which specifically react with the 35 kD CLMF subunit, wherein the monoclonal antibodies are generated against a synthetic peptide containing a 35 kD CLMF subunit amino acid sequence.

**3.     Explanation Why Claims 33-38  
Correspond To The Proposed Count**

Claims 33-38 do not correspond exactly to the proposed count, but all of these claims should be designated as corresponding to the proposed count because each of the claims is directed to the same patentable invention. 37 C.F.R. §1.601(n).

Each of Applicants' claims is directed to monoclonal antibodies which specifically react with cytotoxic lymphocyte maturation factor (CLMF) protein or one of its subunits. The proposed count recites an antibody which specifically reacts with a protein that is identical to CLMF, or, at most, differs from the protein of the proposed count at two residues within one (30-35 kD) subunit. It is noted that, as discussed above, CLMF and NKSF are alternative designations for the same heterodimeric protein. It is well known that an antibody can be of either monoclonal or polyclonal origin. As such, monoclonal antibodies which specifically react with a particular antigen (in this case CLMF/NKSF) are obvious species of antibodies that specifically react with the antigen.

In particular, Claim 33 and Claim 34, which depends from Claim 33, are directed to monoclonal antibodies which specifically react with CLMF, wherein the CLMF protein is identical to the protein recited in the proposed count or, at most, differs from the protein of the proposed count at two residues within the 30-35 kD subunit, and, as such, are directed to the same patentable invention as the proposed

count. Claims 33 and 34 should, therefore, be designated as corresponding to the proposed count.

First, the size and amino acid sequence of the CLMF 40 kD protein subunit recited in Claim 33 is identical to the 40 kD protein recited in (a) of the proposed count. Specifically the first CLMF subunit recited in Claim 33 exhibits an apparent molecular weight of 40 kD on SDS PAGE under reducing conditions and comprises the amino acid sequence of instant application FIG. 25A-25D from amino acids 23 to 328, which corresponds exactly to the size and amino acid sequence of the first subunit recited in the proposed count.

Further, in light of the fact that the CLMF protein is identical to the protein recited in the proposed count, the CLMF protein exhibits the activity of the protein recited in the proposed count. For example, the instant application demonstrates that CLMF induces proliferation of PHA-activated PBLs (working Example 9, pp. 54-60), as recited in the proposed count and in Claim 2.

The 30-35 kD CLMF subunit recited in Claim 33 exhibits an apparent molecular weight of approximately 30-35 kD under reducing conditions on SDS PAGE and comprises the amino acid sequence of FIG. 26A-26C from amino acid 23 to 219, which, at most, differs by two residues from the 30-35 kD amino acid sequence of the 30-35 kD protein subunit recited in the proposed count.

At most, therefore, the CLMF protein recited in Claims 33 and 34 can only differ from the protein antigen recited in the proposed count by two amino acid residues within one of the protein's subunits. Monoclonal antibodies which specifically react with CLMF are not patentably distinct from the antibodies recited in the proposed count and, therefore, corresponds to the same patentable invention as that of the proposed count. As such, Claims 33 and 34 should be designated as corresponding to the proposed count.

Claim 33 which depends from Claim 33, and independent Claim 37, recite a monoclonal antibody which specifically reacts with the first CLMF (40 kD) subunit. As discussed above, the 40 kD CLMF subunit is identical to the 40 kD subunit recited in the proposed count. The monoclonal antibodies recited in Claims 35 and 37, therefore, specifically react with the 40 kD subunit recited in the proposed count and, therefore, are directed to the same patentable invention as the proposed count. Thus, Claims 35 and 37 should be designated as corresponding to the proposed count.

Claim 36, which depends from Claim 33, and independent Claim 38, recite a monoclonal antibody which specifically reacts with the second CLMF (30-35 kD) subunit. As discussed above, the 30-35 kD CLMF subunit differs, at most, by two residues from the 30-35 kD subunit recited in the proposed count. The monoclonal antibodies recited in Claims



36 and 37, therefore, are not patentably distinct from antibodies which specifically react with the 30-35 kD subunit recited in the proposed count. As such, Claims 36 and 38 are directed to the same patentable invention as the proposed count and should be designated as corresponding to the proposed count.

**III. THE EARLIEST POSSIBLE EFFECTIVE FILING  
DATE OF THE '523 PATENT WITH RESPECT TO  
THE PROPOSED COUNT IS THE SEPTEMBER 8, 1990  
FILING DATE OF THE '038 PATENT**

The '523 patent claims priority through a series of continuation or divisional applications to the '941 application, filed September 18, 1990, which issued as the '038 patent. The specification of the '523 patent is, therefore, identical to that of the '038 patent. The '038 patent claims priority as a continuation-in-part, to the '817 application, filed February 7, 1989, which claims priority as a continuation-in-part to the '945 application, filed November 10, 1988.

Neither the '817 application nor the '945 application provides a Section 101/112 utility or a Section 112, first paragraph, written description or enabling disclosure of an antibody which reacts specifically with a NKSF protein.

Consequently, the '523 patent is not entitled to the benefit of the filing date of either the '945 application or

the '817 application, as a constructive reduction to practice of the invention of the proposed count. Fiers v. Sugano, 25 U.S.P.Q.2d 1601, 1605 (Fed. Cir. 1993); Squires v. Corbett, 560 F.2d 424, 433 (C.C.P.A. 1977); Weil v. Fritz, 572 F.2d 856, 865-66 n.16 (C.C.P.A. 1978).

The '038 patent refers to a polyclonal antiserum that is purportedly directed against the 40 kD subunit of NKSF, although no controls were provided and the specificity of the antiserum was not characterized ('038 patent, c. 23, ll. 5-10). Assuming, arguendo, that the '523 patent is entitled to an effective filing date with respect to the proposed count, the earliest filing date of the '523 patent with respect to the proposed count in September 18, 1990, i.e., the filing date of the '038 patent.

As discussed in detail, below, however, even the specification of the '038 patent fails to provide utility or an enabling disclosure for the full scope of any of the claims of the '523 patent.

**A. The '523 Patent Fails To Provide Support For the Claimed Antibodies**

The '523 patent and the applications to which it claims priority are directed virtually exclusively to the purification and use of NKSF polypeptide, and to identification and expression of clones that encode NKSF polypeptide subunits. The '817 and '945 applications provide

but a single sentence relating to antibodies directed against NKSF proteins:

Other uses for these novel [NKSF] polypeptides are in the development of monoclonal and polyclonal antibodies generated by standard methods for diagnostic or therapeutic use. ('817 application p. 25, ll. 8-11; '945 application p. 18, ll. 14-17)

Clearly, even this sentence was not directed toward teaching one of skill in the art how to make and use antibodies, but, was, in fact, provided to suggest an alternative use for NKSF polypeptides, not antibodies directed against NKSF. Assuming, however, that this sentence was, indeed, primarily directed toward NKSF antibodies, the sentence fails to either provide an enabling disclosure under Section 112, first paragraph, or state a utility for the proposed monoclonal or polyclonal antibodies.

The '038 patent and, therefore, the '523 patent, contains the single sentence discussed above. ('038 patent c. 16, ll. 44-47) The '038 patent also refers to a polyclonal rabbit antiserum purportedly directed against the 40 kD subunit of NKSF ('038 patent c. 23, ll. 5-10). While the antiserum was reported to block NKSF activity in vitro, no controls were provided to verify either that the antiserum did, in fact, contain antibodies directed against the 40 kD subunit of NKSF, or to demonstrate the specificity of the antiserum's "blocking" effect. This additional reference to NKSF polyclonal antibodies, however, fails to cure the

deficiencies in the earlier specifications in that it neither provide a utility for NKSF antibodies nor does it describe or provide an enabling disclosure for the entire scope of the antibodies claimed in the '523 patent.

The deficiencies of the '523 patent and the applications to which it claims priority are discussed in detail, below.

1. The '523 Patent Fails To Provide a Utility For the Claimed Antibodies

A patent specification must enable the making of a claimed compound and must also enable one of skill in the art to use that compound. 35 U.S.C. § 112, first paragraph. In re Wright, 999 F.2d, 1557, 1561, 27 U.S.P.Q.2d, 1510, 1513 (Fed. Cir. 1993); Amgen Inc. v. Chugai Pharma Co., 927 F.2d, 1200, 1212, 18, U.S.P.Q.2d, 1016, 1026 (Fed. Cir. 1991); Fujikawa v. Wattansin, 93 F.3d, 1559, 1563, 39 U.S.P.Q.2d, 1895, 1898-1899 (Fed. Cir. 1996) ("[It] is well established that a patent may not be granted to an invention unless substantial or practical utility for the invention has been discovered and disclosed."; emphasis added). Moreover, a patent must disclose a practical utility for a claimed compound. In re Zienler, 992 F.2d 1197, 1201, 26 U.S.P.Q.2d 1600, 1603 (Fed. Cir. 1993); Kawai v. Metlesics, 480 F.2d 880, 886, 178 U.S.P.Q. 158, 163 (C.C.P.A. 1973); see also Cross v. Iizuka, 753 F.2d 1040, 224 U.S.P.Q. 739, 742 (Fed. Cir. 1985);

Brenner v. Manson, 383 U.S. 519, 148 U.S.P.Q. 689, 693-696 (1966).

It has been repeatedly held that a deficiency under 35 U.S.C. § 101 (lack of utility) also creates a deficiency under 35 U.S.C. § 112, first paragraph (lack of enablement). See In re Brana, 51 F.3d 1560, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995).

The only reference made to utility for an NKSF antibody provided in the specification of the '523 patent or any of the applications to which it claims priority is that such antibodies can be put to "diagnostic or therapeutic use." (e.g., '523 patent, c. 10, l. 28) The specifications, however, fail to provide either a practical therapeutic or diagnostic use for an NKSF antibody.

**The '523 Patent Provides No Therapeutic Use  
For NKSF Antibodies**

Neither the specification of the '523 patent nor those of the applications to which it claims priority provide therapeutic uses for NKSF antibodies. The only therapeutic uses described in these specifications are exclusively limited to administration of NKSF polypeptides, subunits or fragments thereof ('523 patent c. 3, ll. 34-48; c. 10, ll. 18-21; c. 10, l. 29 to c. 11, l. 8). The '523 patent, however, provides absolutely no teaching for therapeutic uses that involve

administration of an antibody which specifically reacts with NKSF.

Further, each of the therapeutic uses recited in the specifications require an increase in NKSF activity, and each of the disorders contemplated for treatment are ones characterized as pathological states which may benefit from enhanced natural killer (NK) cell function ('523 patent c. 3, ll. 34-39). As pointed out in the Background section of the '523 patent, NK cells are a subset of lymphocyte cells active in the immune system that were known to be involved in defense against tumors, viral infection and hematopoiesis ('523 patent, c. 1, ll. 21-32). As such, the '523 patent teaches methods for treating cancer, radiation or drug exposure, bacterial and viral (e.g., HIV) infections, anemia, B cell or T cell deficiencies including immune cell or hematopoietic cell deficiency following a bone marrow transplantation ('523 patent; c. 3, ll. 34-39; c. 9, l. 66, to c. 10, l. 14), i.e., disorders that would benefit from an increase in NKSF activity.

Thus, even if the specifications had explicitly taught use of NKSF antibodies as part of the disclosed therapeutic methods, the NKSF antibodies would be required to increase NKSF activity such that NK cell function is enhanced. As discussed in the accompanying Declaration of Dr. David H. Presky, an expert in the IL-12 field, antibodies which specifically bind NKSF, however, would fail to either increase

NKSF activity or to enhance NK cell function. Rather, administration of such antibodies would either have no effect on either NKSF activity or NK cell function, or, if an effect was observed, administration of anti-NKSF antibodies would actually decrease or abolish (i.e., "neutralize") NKSF activity or NK cell function (Presky Declaration ¶ 8).

In order for an NKSF antibody to increase NKSF activity and, therefore, enhance NK cell function, the antibody would be required to at least partially mimic or induce NKSF action. An antibody directed against a soluble factor such as NKSF, however, would, if anything, exert the opposite effect. For example, an antibody which specifically binds NKSF could act to inhibit or weaken binding of NKSF to the cellular receptor or receptors to which it would normally bind and through which it would normally act to enhance NK cell function (Presky Declaration ¶ 9). The negative activity of such an antibody is exemplified in the '038 patent itself, in that the only NKSF antibody collection it mentions is a polyclonal antiserum is reported to block NKSF activity in an in vitro assay ('038 patent, c. 23, ll. 5-10). While, as discussed below, the specificity and neutralizing activity of the antiserum described in the '038 patent is questionable, clearly, the Applicants taught that the only NKSF antiserum produced exhibited a negative effect on NKSF.

Finally, while it is noted that the specifications make reference to coadministering NKSF polypeptide with a

"cytokine, hematopoietin, interleukin, growth factor or antibody" (e.g., '523 patent c. 3, ll. 39-44; emphasis added), the reference to an antibody clearly refers to an antibody other than an NKSF antibody. In particular, for the reasons discussed above, coadministering NKSF along with an antibody that binds to the NKSF would be ineffective in that the binding, if it exhibited any effect at all, would only serve to lower or abolish the NKSF activity.

**The '523 Patent Provides No Diagnostic Use  
For NKSF Antibodies**

With respect to diagnostic uses, the specifications of the '523 patent and those of the applications to which it claims priority, fail to describe any diagnostic uses, let alone a practical diagnostic use for an antibody which specifically reacts with NKSF. In addition to a complete lack of explicit teaching of diagnostic uses, none of the disorders the specifications list as being influenced by NKSF are described in a manner that would in any way even suggest that such disorders could be diagnosed using an antibody which specifically binds to NKSF.

In particular, while the specifications teach that diseases or disorders such as cancer, viral and bacterial infections, and hematopoietic deficiencies can be treated by increasing NKSF activity or enhancing NK cell function, the '523 patent fails to address or even speculate as to whether any of these diseases or disorders is caused by or at least



involves an abnormal level of NKSF and, therefore, might possibly be amenable to diagnosis via NKSF measurement. More importantly, the specifications even fail to teach what levels of NKSF are normally present, another prerequisite for any sort of diagnosis via measurement of NKSF levels.

Specifically, while an increase in NKSF activity may very well be beneficial in treating one or more of the diseases or disorders listed in the specifications, this in no way indicates that less than normal NKSF levels are usually present in such disease or disorder states. To the contrary, it is quite possible that normal levels of NKSF are present in each of the disease or disorder states listed in the specifications. Applicants, in fact, verify that even years after the September 18, 1990 filing date of the '038 patent no information existed concerning NKSF levels produced by normal blood cells. See D'Andrea et al.<sup>1/</sup>, a November 1992 a scientific publication co-authored by a subset of the Applicants listed on the '523 patent: "...nothing was known about the ability of normal cells to produce biologically active NKSF/IL-12" (D'Andrea et al., p. 1338, left column).

In the complete absence of teaching relating to normal NKSF levels or any indication that a single one of the disease states or disorders is or even may be caused by

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<sup>1/</sup> D'Andrea, A. et al., 1992, "Production of Natural Killer Cell Stimulatory Factor (Interleukin 12) by Peripheral Blood Mononuclear Cells", J. Exp. Med. 176:1387-1398, a copy of which is attached hereto as Exhibit F.

abnormal levels of NKSF, the teaching in the specifications fails to even suggest any diagnostic uses, let alone a diagnostic use for an antibody which specifically binds NKSF. As pointed out in D'Andrea et al., it was only by producing antibodies which specifically bind NKSF that an investigation was carried out to determine the levels of production or NSKF by normal blood cells. Essentially, then, Applicants acknowledge in D'Andrea et al. that, at least for a practical diagnostic use for NKSF antibodies, it would have been necessary for one of skill in the art to first make antibodies and then do extensive characterization and experimentation before amassing the basic information that would have been necessary to cover embark on development of a diagnostic use for such antibodies. This, however, is not sufficient for fulfilling a utility requirement. A "patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion", Brenner v. Manson, supra, 383 U.S. 519, 536, 148 U.S.P.Q. 689, 696.

Thus, as discussed above, neither the specification of the '523 patent nor those of the applications to which it claims priority state a practical utility for the claimed antibodies.

2. The '523 Patent Fails To Enable the Claimed Antibodies

35 U.S.C. § 112, first paragraph, requires that the specification enable the claims. "[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" In re Wright, *supra*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2d 1510, 1513; Amgen, *supra*, 927 F.2d 1200, 1212, 18 U.S.P.Q.2d 1016, 1026. In addition, "the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art." In re Fisher, 427 F.2d 833, 839, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970).

While enablement is not precluded even if some experimentation is necessary, the amount of experimentation need must not be unduly extensive. Hybritech v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231, U.S.P.Q. 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). Factors to be considered in determining whether a disclosure would require undue experimentation include: the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art and the breadth of the claims. In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988).

As a matter of law, the purported knowledge of those in the art cannot be relied upon to "substitute for a basic enabling disclosure". Genentech, Inc. v. Novo Nordisk, AIS, 108 F. 3d 1361, 42 U.S.P.Q.2d 1001 (Fed. Cir. 1997), cert. denied, \_\_\_ U.S. \_\_\_, 118 S.Ct. 397 (1997) (hereinafter, "Novo Nordisk").

In order to satisfy the written description requirement, the specification itself must lead the skilled worker to the subject matter of the claims. Fujikawa, supra, 93 F.3d 1559, 1570, 39 U.S.P.Q.2d 1895, 1904; In re Ruschig, 379 F.2d 990, 995, 154 U.S.P.Q. 118, 123 (C.C.P.A. 1967); Rohm & Haas Co. v. Mobil Oil Corp. 718 F. Supp. 274 (D. Del. 1989), aff'd, 895 F.2d 1421 (Fed. Cir. 1990).

The '945 application and the '817 application provide no teaching regarding how to make antibodies which specifically react with NKSF beyond stating that antibodies could be made using "standard methods" ('817 application p. 25, ll. 8-11; '945 application p. 18, ll. 14-17). The specification of the '038 patent, and therefore that of the '523 patent, additionally includes a reference to a rabbit polyclonal antiserum that is reportedly directed against the 40 kD subunit of the NKSF polypeptide ('038 patent c. 23, ll. 5-10). As discussed in detail above, the only uses stated for an antibody which specifically binds an NKSF polypeptide is that such antibodies can be used "for diagnostic or therapeutic use" (e.g., '523 patent c. 10, ll. 25-28).

The specifications of the '523 patent and those of the applications to which it claims priority fail to provide either adequate written description for the claimed antibodies or sufficient teaching to enable one of skill in the art to make and use the claimed antibodies. In particular, as set forth below, the '523 patent and its parent applications fail to adequately describe or teach: 1) how to make the full scope of the claimed antibodies, in general; 2) how to make and use NKSF antibodies for therapeutic use; or 3) how to make and use NKSF antibodies for diagnostic use.

**The '523 patent Fails to Describe or Teach  
How to Make the Full Scope of the Claimed Antibodies**

The claims of the '523 patent encompass both monoclonal and polyclonal antibodies, as well as antibodies directed against the 40 kD subunit or ones directed against the 30-35 kD subunit of NKSF. Among the antibodies encompassed by the claims of the '523 patent are antibodies of either murine or human origin (see dependent Claims 4 and 5). The teaching provided in the specifications of the '523 patent or the applications to which it claims priority, however, neither adequately describes such antibodies nor enables the skilled artisan to make full scope of the claimed antibodies.

For example, no written description support is provided for the terms "murine antibody" or "human antibody," nor is adequate written description support provided for how

to make such antibodies, e.g., monoclonal antibodies. Written description support for the terms "murine" or "human" antibody was not, in fact, introduced until October 22, 1997, when such terms were included in a set of claims filed by preliminary amendment in connection with the filing of the '240 application, from which the '523 patent issued. Further, the specifications are completely silent as to how one of skill in the art could go about generating a human antibody which specifically reacts with the human NKSF protein antigen recited in the claims of the '523 patent. Surely, a method for how to make a human antibody directed against a human antigen without having to resort to undue experimentation was well beyond the state of the art at the time the applications were filed and would require significantly more teaching than the vague reference to "standard methods" provided.<sup>2/</sup>

With respect to antibody production, in general, the specifications teach only that "monoclonal and polyclonal antibodies can be generated by standard methods" ('817 application, p. 25, ll. 8-11; '945 application, p. 18, ll. 14-17). The specifications fail, however, to provide a working example for how to make either a polyclonal or a monclonal

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<sup>2/</sup> It is further noted that the claims of the '523 patent do not require that the recited antibodies be in anyway "isolated". Clearly, then the possibility exists that antibodies produced as a result of certain human autoimmune disorders could include antibodies which specifically react with human NKSF, thereby inherently anticipating the claims as the '523 patent.

antibody, or to describe what particular "standard" methods could be used to produce such antibodies.

The '038 patent refers to a polyclonal rabbit antiserum directed against the 40kD NKSF subunit ('038 patent c. 23, ll. 5-10). No controls or characterization of the antiserum are provided. The only indication that an antibody which specifically reacts with NKSF might be present in the antiserum is based on the antiserum's purported NKSF inhibitory activity. One of skill in the art, however, would find the NKSF-related specificity of the reported result questionable both in light of the high antiserum concentration utilized (only a 1:100 dilution) and the lack of controls presented (Presky Declaration ¶ 10). The questionable nature of this result is corroborated by the fact that control monoclonal hybridoma supernatants containing control antibodies has since been reported to exhibit a new specific inhibitory effect in IL-12 (i.e., NKSF) bioactivity.<sup>3/</sup>

As further evidence that the specifications fail to enable the full scope of the claimed antibodies, the specifications fail to teach one of skill in the art how to make antibodies which specifically react with the NKSF 30-35 kD subunit without undue experimentation. In particular, as discussed below, production of antibodies which specifically

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<sup>3/</sup> p. 1554, right column, Chizzonite, R. et al., 1991, "IL-12: Monoclonal Antibodies Specific For the 40 kDa Subunit Block Receptor Binding and Biologic Activity Of Activated Human Lymphoblasts," J. Imm. 147:1548-1556, a copy of which is attached hereto as Exhibit G.

react with the 30-35 kD NKSF subunit would be difficult, if not impossible, by merely utilizing "standard" methods. Because the specifications apparently fail to appreciate the difficulties involved with generating antibodies directed against the 30-35 kD subunit, the specifications provide no details that would allow one of skill in the art to make such antibodies without having to resort to undue experimentation.

First, making antibodies, especially monoclonal antibodies, which specifically bind the NKSF 30-35 kD subunit is difficult, if not impossible, when using purified or reconstituted NKSF heterodimer is used as the antigen. Dr. Presky, in fact, does not know of a single instance when purified NKSF has successfully be used to generate a monoclonal antibody against the 30-35 kD subunit of NSKF (Presky Declaration ¶ 13). This fact is also illustrated by the results reported in D'Andrea et al. and in Chizzonite et al., a scientific paper co-authored in 1991 by a subset of Applicants of the instant application.

Both D'Andrea et al. and Chizzonite et al. concern generation of antibodies directed against IL-12 (i.e., NKSF/CLMF) and both of these publications point out the difficulties associated with attempting to produce antibodies which specifically bind to the NKSF 30-35 kD subunit when a purified sample of NKSF heterodimer is used as the starting antigen. The results in D'Andrea et al. state that antibodies generated against recombinantly produced NKSF heterodimer



(referred to in D'Andrea as "C11" antibodies) fail to react with the 30-35 kD NKSF subunit and exhibit a reactivity pattern similar to antibodies generated against just the NKSF 40kD subunit (referred to in D'Andrea et al. as the "C8 series" of antibodies), i.e., only react with the 40 kD subunit (D'Andrea et al., p. 1390, left column, and Figure 1).

Chizzonite et al. reports on monoclonal and polyclonal antibodies directed against IL-12 (NKSF) generated using purified or partially purified NKSF heterodimer. The results presented in Chizzonite et al. also point out that using purified NSKF resulted only in the generating of antibodies which specifically bind the 40kD subunit (Chizzonite et al., p. 1554, left column). That is, no antibodies were produced which specifically react with the 30-35 kD subunit. In attempting to explain the reason for the apparent preference for antibodies directed against the 40 kD subunit, Chizzonite et al. points out that significant amounts of the free 40 kD subunit are present in purified IL-12 samples, which can bias toward identification of antibodies against the 40 kD subunit (Chizzonite et al., p. 1555, left column). Chizzonite et al. also reports that, apparently, antibodies against the 30-35 kD subunit arise "only after multiple immunizations", as opposed to antibodies against the 40 kD subunit, which arise very rapidly (Chizzonite et al., p. 1555, left column).

Clearly, then, the results presented in both D'Andrea et al. and Chizzonite et al. demonstrate that when "standard" methods, such as using purified NKSF antigen are employed to produce antibodies that recognize the 40 kD subunit as well as antibodies that recognize the 30-35 kD subunit, such methods fail to yield antibodies of the full scope as those antibodies claimed in the '523 patent.

Although no written description support is provided for this in the specifications, one possible method that could be utilized in attempting to generate antibodies which specifically bind the NKSF 30-35 kD subunit would be to recombinantly express a nucleic acid that encodes the 30-35 kD subunit alone and subsequently use the recombinantly produced 30-35 kD subunit as an antigen. Neither the '817 application nor the '945 application teach or support such a starting material, however, because neither of these applications disclose either the amino acid sequence of the NKSF 30-35 kD subunit or a nucleic acid sequence encoding the subunit. Further, while the '038 patent provides an amino acid and nucleotide sequence for the NKSF 30-35 kD subunit, the '038 patent fails to describe that recombinantly expressed subunit can be used as a starting material for antibody generation, and certainly fails to teach that such starting material is preferable, and possibly necessary, for generation of some antibodies. Finally, it is noted that the '945 specification provides six very short stretches of amino acid sequences--

each between only five and eight residues in length--obtained from peptide sequencing or partially purified NKSF polypeptide ('945 application, p. 3, ll. 13-21). Although the '945 application erroneously concludes that the 70 kD NKSF polypeptide is a homodimer of 40 kD subunits, later analysis reveals that three of the short sequences disclosed lie within the 30-35 kD subunit.

While no written description support is provided for this, it theoretically would have been possible to attempt to generate antibodies directed against these short sequences. The specification fails, however, to enable one or skill in the art to make antibodies generated against the disclosed fragments because "standard" methods would not be sufficient to produce antibodies against peptide sequences as short as 5-8 residues in length without undue experimentation. See, e.g., Harlow & Lane, a 1988 laboratory manual of techniques for antibody production and use that reflects the state of the art at the time the '945 application was filed<sup>4/</sup>. As pointed out in Harlow & Lane<sup>5/</sup>, while synthetic peptides as short as 6 amino acid residues can be used to produce antibodies against a protein, the response obtained with such short sequences vary, and, as such, standard methods teach that peptides of at least approximately 10 residues in length should be used.

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<sup>4/</sup> "Antibodies: A Laboratory Manual," 1988, Harlow, E. & Lane, D., eds., Cold Spring Harbor Laboratory, New York; a copy of p. 76 in attached hereto as Exhibit H.

<sup>5/</sup> p. 76, Harlow & Lane.

The '817 application discloses an additional peptide-- a thirteen amino acid residue sequence--that is characterized as being part of the 30-35 kD NKSF subunit ('817 application, p. 5, ll. 9-11). When compared to the amino acid sequence of the full-length subunit that was ultimately obtained, the fragment disclosed in the '817 application contains several errors throughout its sequence, such that the longest stretch of correct sequence is only five residues in length. Even if the specification had taught using this sequence as a starting material for generating an antibody directed against the 30-35 kD NKSF subunit, the spurious sequence would have prevented one of skill in the art from making such antibodies without undue experimentation.

**The '523 patent Fails to Teach One of Skill in the Art  
How to Make and Use NKSF Antibodies for Therapeutic Use**

Each of the therapeutic uses recited in the specification of '523 patent and those of the applications to which it claims priority requires an increase in NKSF activity, and each of the disorders contemplated for treatment (e.g., cancer treatment, treatment of bacterial or viral infections and treatment of blood cell disorders, such as immune or hematopoietic cell deficiencies) would benefit from enhanced natural killer (NK) cell function (e.g., '523 patent c. 3, ll. 34-39). The specification of the '523 patent and those of the applications to which it claims priority describe

no methods of treatment that involve administration of antibodies which specifically react with NKSF. Further, even if these specifications had actually described any NKSF antibody-based therapeutic methods, the specifications also fail to teach one of skill in the art how to make antibodies exhibiting an enhancing activity that could be used as part of such methods.

NKSF is a secreted polypeptide cytokine that exerts its activity by interacting with one or more cell surface receptors for which it exhibits specificity. NKSF interaction initiates or modulates a signal transduction cascade that ultimately results in the cellular responses characterized as NKSF activities (e.g., production of gamma interferon, induction of T cell proliferation or enhancement of NK cell function). To increase NKSF activity, therefore, an antibody which specifically reacts with NKSF would either need to either mimic or partially mimic NKSF activity independent of NKSF per se. Alternatively, binding of the antibody to NKSF would be required to increase the bound NKSF polypeptide's activity.

In practice, however, antibodies which specifically react with NKSF would fail to either increase NKSF activity or to enhance NK cell function, especially if merely "standard" methods are utilized for producing such antibodies. Specifically, an antibody directed against a soluble factor such as NKSF would, upon binding the factor, either exhibit no

effect on the factor's activity or, would decrease or abolish the factor's activity, i.e., would actually result in the opposite of the desired enhancing effect (Presky Declaration ¶ 9, 10).

Clearly then, antibodies which not only specifically react with soluble factors such as NKSF but also enhance the activity of the factors to which they are directed were not generally known or routinely made at the time any of the applications were first filed. Silence in the specifications as to how to go about generating NKSF "enhancing" antibodies must amount to much more than merely an omission of a minor detail. For example, the specification provides no teaching at all relating to what particular portion or portions of NKSF or NKSF subunits should be used as starting antigen material for producing such enhancing antibodies.

For the reasons presented above, therefore, the specification of the '523 patent and those of the applications to which it claims priority fail to enable a therapeutic use in that one of skill in the art following the teaching provided in the specifications to utilize "standard methods," even when coupled with the state of the art, would clearly have had to resort to undue experimentation in developing an NKSF antibody exhibiting the required NKSF enhancing activity.

**The '523 patent Fails to Teach One of Skill in the Art  
How to Make and Use NKSF Antibodies for Diagnostic Use**

The specification of the '523 patent and those of the applications to which it claims priority fail to describe or provide teaching relating to any diagnostic uses, beyond the mere statement that NKSF antibodies can be developed for diagnostic use (e.g., '523 patent c. 10, ll. 25-28). The mere declaration that NKSF antibodies could be used for diagnostic purposes, however, even when coupled with the state of the art at the time any of the specifications was first filed, does not provide sufficient teaching to allow one of skill in the art to make or use NKSF antibodies for diagnostics without undue experimentation. Tossing out the mere germ of an idea does not constitute enabling disclosure. Brenner v. Manson, supra, 383 U.S. 519, 536, 148 U.S.P.Q. 689, 696.

First, the specifications provide none of the teaching regarding NKSF levels that would be necessary for one of skill in the art to utilize NKSF antibodies in diagnosing any of the diseases or disorders the specifications list. In particular, no teaching is provided relating to what levels of NKSF are produced either normally or in a disease/disorder state. Further, this information was not within the state of the art at the time even as late as when the '038 patent was filed. This is acknowledged by the November 1992 publication by D'Andrea et al., co-authored by a subset of the inventors of the '523 patent, which states that prior to the study reported in the publication, nothing had been known about the production of NKSF (IL-12) in normal blood cells (D'Andrea et

al., p. 1388, left column). Further, even if an increase in NKSF activity might be beneficial in treating one or more of the diseases or disorders listed, this fails to address whether abnormal NKSF levels are usually present in such disease or disorder states. It is, in fact, possible that normal levels of NKSF are present in each of the disease or disorder states listed in the specifications.

Further, the specifications apparently fail to appreciate and certainly fail to teach that an NKSF antibody-based diagnostic use would be operable only when certain types or sets of NKSF antibodies exhibiting particular characteristics are employed. This is due to the fact that conditions that promote production of biologically active NKSF heterodimer also promote production and secretion of free NKSF 40 kD subunit, which does not exhibit the heterodimeric activity. Thus, any useful diagnostic assay would be required to distinguish between the heterodimeric NKSF and the free NKSF 40 kD subunit (Presky Declaration ¶ 11).

Specifically, conditions that stimulate production of biologically active NKSF heterodimer also induce production of a large excess free 40 kD NKSF. (See, e.g., Chizzonite et al., p. 1555, paragraph bridging left and right columns; and D'Andrea et al., Figure 4A-4B, p. 1392, and accompanying text.) The 40 kD subunit alone, however, exhibits no biological activity. (See, e.g., Chizzonite et al., Table III, p. 1553; and D'Andrea et al., Figure 4A-4B, p. 1392, and



accompanying text.) Thus, a successful antibody-based diagnostic use would require employing an antibody or antibodies that can somehow distinguish between the the 70 kD NKSF heterodimer and the free 40 kD NKSF subunit.

The specifications, however, are silent regarding any of these points<sup>6/</sup> and provide absolutely no guidance whatsoever regarding particular sorts of antibodies (e.g., an antibody which reacts specifically with the 70 kD heterodimer, but not either of the subunits, or, alternatively, a combination of antibodies that, together, can distinguish between the 70 kD heterodimer) that could be successful in an NKSF diagnostic context. Thus, even if teaching had been provided concerning NKSF levels in normal and disease/disorder states, the specification of the '523 patent and those of the applications to which it claims priority still fail to provide adequate teaching that would enable one of skill in the art to utilize NKSF antibodies for diagnostic purposes.

**IV. APPLICANTS ARE ENTITLED TO THE BENEFIT OF  
THE AUGUST 27, 1990 FILING DATE OF THEIR  
'284 APPLICATION FOR THE PROPOSED COUNT**

Applicants are entitled to the benefit of the August 27, 1990 filing date of their '284 application because the

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<sup>6/</sup> While it is noted that the specifications stated that reduction of native 70 kD NKSF destroys its activity (e.g., '523 patent, c. 13, ll. 23-25), this does not rule out the possibility that the reducing conditions also destroyed any possible biological activity of either or both of the subunits.

'284 application meets the Section 112, first paragraph, written description and enablement requirements of at least one species within the proposed count. Squires v. Corbett, 560 F.2d 424,433 (C.C.P.A. 1973) and Weil v. Feitz, 572 F.2d 856, 865-66 n.16 (C.C.P.A. 1978).

The instant application is a divisional application of the '151 application, which is a divisional application of the '011 application, which is a divisional of the '023 application, which is a continuation-in-part of the '284 application.

The '284 application describes the purification and characterization of cytolytic lymphocyte maturation factor (CLMF) and the cloning of nucleic acid sequences encoding each of the two CLMF subunits. As discussed above, the CLMF heterodimeric polypeptide is identical to NKSF and IL-12.

With respect to the proposed count and the claims of the instant application, each of which should be designated as corresponding to the proposed count, the '284 application describes the production and characterization of monoclonal antibodies which specifically react with CLMF. In particular, with respect to antibodies which specifically react with CLMF, the '284 application describes: a) the production of monoclonal antibodies which specifically react with either the 40 kD or the 30-35 CLMF subunit (p. 5, l. 10 to p. 6, l. 6; Example 13, pp. 74-82; Example 14, pp. 83-85); b) provides extensive teaching regarding practical utilities for such CLMF

antibodies (p. 6, l. 8 to p. 7, l. 15); and c) provides ample methods for assaying such antibodies (p. 28, l. 6 to p. 31, l. 30).

Unlike the specification of the '523 patent and those of the applications to which it claims priority, the '284 specification teaches one of skill in the art how to both make and use the antibodies claimed in the instant application. First, the '284 application provides extensive practical utilities for the CLMF monoclonal antibodies claimed in the instant application. In contrast to the '523 patent and the applications to which it claims priority, the utilities stated in the '284 application are not limited to only therapeutic or diagnostic uses. For example, among the uses of the monoclonal antibodies stated in the '284 application is use of the antibodies as affinity reagents for CLMF purification ('284 application, p. 6, ll. 27-29). Further, although the '284 application does present therapeutic uses for CLMF antibodies, it explicitly teaches treating processes that would benefit from a decrease in CLMF activity, i.e., selective blockade of proliferation and activation of cytotoxic T cells, such as would be beneficial when utilized as part of transplantation procedures ('284 application p. 7, ll. 11-15). Thus, unlike that of the '523 patent and its parents, the teaching in the '284 application avoids the difficulties inherent in generating "enhancing" antibodies against a soluble factor such as CLMF..

The '284 application also teaches one of skill in the art how to make the full scope of the claimed antibodies without undue experimentation. In particular, the '284 application provides ample teaching relating to how to make monoclonal antibodies which specifically react with CLMF, including methods for producing monoclonal antibodies directed against the 30-35 kD CLMF subunit. For example, the '284 application describes and demonstrates the generation and characterization of twenty monoclonal antibodies which specifically react with CLMF (working Example 13, pp. 74-82; summarized at pp. 5-6). The monoclonal antibodies generated were characterized using appropriate controls and were found to specifically bind the 40 kD subunit of CLMF. Certain of the monoclonal antibodies were found to exhibit CLMF neutralizing activity, including the ability to neutralize CLMF activity in the TGF assay.

The '284 application also explicitly describes and teaches how to make monoclonal antibodies which specifically react with the 30-35 kD CLMF subunit (Example 14, pp. 83-85). In particular, the '284 application teaches that synthetic peptides based on the amino acid sequence of the 35 kD CLMF subunit can be used to prepare monoclonal antibodies to this subunit. Specifically, the example describes production of antibodies generated against an 11 amino acid residue synthetic peptide containing a sequence of the 30-35 kD CLMF subunit. While the particular antibodies produced in the

example were polyclonal, the specification clearly teaches that monoclonal antibodies utilizing such a synthetic peptide antigen could be used to generate monoclonal antibodies.

The '284 application clearly describes monoclonal antibodies which specifically react with CLMF, and provides ample teaching for how to make such antibodies. As the '284 application provides a wide range of practical utilities, among which are ones (e.g., use of the antibodies for purification purposes) that require only that the monoclonal antibodies specifically bind CLMF, the application has also adequately taught one of skill in the art how to use the monoclonal antibodies without undue experimentation.

Thus, as discussed below, the '284 application fully meets the requirements of Sections 101 and 112, first paragraph, with respect to the proposed count. As such, Applicants are entitled to the benefit of the August 27, 1990 filing date of the '284 application for the proposed count.

**V. BECAUSE APPLICANTS' EFFECTIVE FILING DATE IS LESS THAN THREE MONTHS AFTER THE EARLIEST POSSIBLE EFFECTIVE FILING DATE OF THE '523 PATENT, APPLICANTS FILE HEREWITH A DECLARATION UNDER 37 C.F.R. §1.608(a)**

Applicants have established above that Applicants' effective filing date for the subject matter of the proposed count is August 27, 1990 and the earliest possible effective filing date of the '523 patent is September 18, 1990. Since these dates are within three months of each other, Applicants

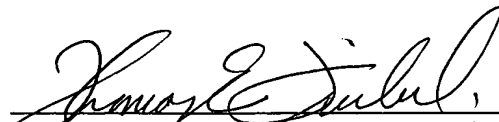
or Applicants' Attorney or Agent of Record need file only an affidavit (declaration) under 37 C.F.R. §1.608(a) alleging that there is a basis upon which Applicants are entitled to judgment relative to the patentee of the '856 patent. An appropriate Declaration of Thomas E. Friebel Under 37 C.F.R. §1.608(a) accompanies this Request.

**VI. CONCLUSION**

Applicants seek declaration of an interference in which there is one count relating to an antibody which specifically reacts with a NKSF/CLMF/IL-12 polypeptide. Applicants' Claims 1-16 and Claims 1-7 of the '523 patent should be designated as corresponding to the proposed count. Action to that end is earnestly solicited. Applicants should be accorded benefit of the filing date of their application Serial No. 572,284, filed August 27, 1990, and the '523 patent should be accorded benefit of the filing date of application Serial No. 584,941, filed September 18, 1990.

Respectfully submitted,

Date: September 22, 1999

  
Thomas E. Friebel 29,258  
(Reg. No.)

PENNIE & EDMONDS  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

ATTACHMENTS:

Declaration of Thomas E. Friebe Under 37 C.F.R. § 1.608(a)

Declaration of Dr. David H. Presky.

Exhibit A: Trinchieri et al. United States Patent No. 5,811,523  
Exhibit B: Trinchieri et al. United States Patent No.  
5,457,038.  
Exhibit C: Trinchieri et al. Application Serial No. 08/307,817.  
Exhibit D: Trinchieri et al. Application Serial No. 08/269,945.  
Exhibit E: Gately et al. Application Serial No. 08/572,284.  
Exhibit F: D'Andrea et al., 1992, J. Exp. Med. 176:1387-1398.  
Exhibit G: Chizzonite et al., 1991, J. Imm. 147:1548-1556.  
Exhibit H: Harlow & lane, p. 76.